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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

MANTIS MERCADER, ELENI M

ART UNIT PAPER NUMBER

3737

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,473

Applicant(s)

GOVARI, ASSAF

Examiner

Eleni Mantis Mercader

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

The Examiner respectfully disagrees with the Double Patenting arguments because Double Patenting rejections are not just to prevent patent term extension, but also to avoid cross-licensing therefore the filing dates are irrelevant. With respect to the Fabian reference, the Examiner provided a functional equivalency statement, which has been ignored. Furthermore, even if Brodie is non-analogous art, the reference still provides a solution to a common problem, which is localization by conserving power and error reduction constituting the motivation to combine. Therefore the rejections are maintained and made final.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-77 of copending Application No. 10/313,702. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent alternate variations and groupings.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/173,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent alternate variations and groupings.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/173,197. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent alternate variations and groupings.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/173,339. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent alternate variations and groupings.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabian'095 in view of Schneider'043 and Brodie'545.

Fabian'095 teaches all the elements of the current invention including an apparatus for tracking an object, comprising:

a plurality of field generators, adapted to generate electromagnetic fields at different, respective frequencies in a vicinity of the object, while the one or more field generators are placed outside the body (see col. 5, lines 37-44 and see col. 7, lines 45-47);

a wireless transponder, fixed to the object and wherein the transponder is adapted to be inserted, together with the object, into a body of a subject (see col. 3, lines 66-68, referring to the marker 18 being placed on a surgical implement such as a sponge and see col. 4, lines 20-34; referring to the marker being an LRC marker circuit, thereby wireless) and wherein the object could be a surgical instrument (see Figure 6b);

the transponder comprising:

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at least one sensor coil, coupled so that an electrical current flows in the at least one sensor coil responsive to the electromagnetic fields (see col. 5, lines 25-26; referring to the printed circuit coil).

While Fabian'095 does not teach a control circuit coupled to the at least one sensor coil so as to generate an output signal indicative of the current and wherein the control circuit is adapted to generate the output signal so as to indicate a phase of the current flowing in the at least one sensor coil, relative to a phase of the electromagnetic fields, Fabian'095 does teach that the marker has a signal identity characterized by phase/lag lead and when the ac field is removed the circuit exhibits a ring-down which is detectable and indicative of its presence (see col. 5, lines 30-63). Therefore, the circuit as taught by Fabian'095 is a functional equivalent of the combination of the sensor coil and the control coil, in that it provides the same end result of providing a response to the interrogation field, which is detectable and indicative of its presence.

Fabian'095 also teaches a signal receiver to determine the presence of the object (see col. 5, lines 44-47).

Fabian'095 does not teach the determination of the position coordinates of the surgical implement. In the same field of endeavor, Schneider'043 teaches the use of electromagnetic interrogation to accurately determine the remote position of the surgical probe of interest (see col. 4, lines 42-63). It would have been obvious to one skilled in the art at the time that the invention was made to have modified Fabian'095 and incorporated the teachings of Schneider'043 in order to determine the position of the surgical instrument or implement of interest in relatively non-invasive procedures where there is no open wound or direct plain view

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by the surgeons but rather an insert able instrument such as a catheter or a probe in the patient wherein its position needs to be determined for guiding purposes as less invasive procedures become more prominent.

Fabian'095 in view of Schneider'043, do not teach the use of a power coil, coupled to receive the RF driving field and to convey electrical energy from the driving field to the control circuit, and further coupled to transmit the output signal generated by the control circuit.

In the same field of endeavor, Brodie'545 teach the use of a transponder having a power coil, coupled to receive the RF driving field and to convey electrical energy from the driving field to the control circuit, and further coupled to transmit the output signal generated by the control circuit (see col. 6, lines 12-36).

It would have been obvious to one skilled in the art at the time that the invention was made to have modified Fabian'095 in view of Schneider'043 and incorporated the teachings of Brodie'545 by using a low power wireless transponder in an electromagnetic interrogation system, in order to provide a simple but reliable communication link of the position of the object of interest which conserves power and reduces possibility of transmission error (see for motivation to combine col. 2, lines 18-23).

Furthermore, it would have been obvious to one skilled in the art at the time that the invention was made to have placed these transponders at any implement of interest used during surgical procedures such as probes or implants in order to localize them through out the surgical procedure.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Mon. - Fri., 8:00 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eleni Mantis Mercader
Primary Examiner
Art Unit 3737

EMM